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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,482	03/31/2000	Stephen J. Brown	HERO-1-1078	1136

25315 7590 10/30/2003

BLACK LOWE & GRAHAM, PLLC  
701 FIFTH AVENUE  
SUITE 4800  
SEATTLE, WA 98104

EXAMINER
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THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 10/30/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/540,482

Applicant(s)

BROWN, STEPHEN J.

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-17 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This application has been examined.
2. Amendment A, Paper #6, received 5/6/2003, has been entered into record.
3. Claims 1-17 are pending.

#### ***Priority***

4. This application is a continuation of Application 09/394,219, now U.S. Patent Number 6,375,469, which is a continuation of Application 08/814,293, now U.S. Patent Number 5,951,300.
5. The effective filing date for the subject matter defined in the pending claims in this application is 3/10/1997.

#### ***Specification***

6. The specification is objected because of the following informalities:

Line 1 of the specification specifically recites the application 09/394,219 as a priority document as amended on 5/6/2003. This citation fails to provide the patent number which this application has matured, namely U.S. Patent Number 6,375,469.

Appropriate correction is required.

7. The specification fails to properly recite the submitted figures. For example, seven (7) Figures were submitted with the filing of the application, yet the specification recites nine (9) distinct Figures in the "brief description of the drawings" section. This section of the specification MUST accurately describe the associated Figures including each and every element contained therein. See MPEP § 608.01(f), 37 C.F.R. 1.74, 37 C.F.R. 1.83, and 37 C.F.R. 1.84.

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8. It is submitted that either incorrect drawings were submitted with this application or a serious deficiency of the specification exists. Revision of the drawings is required to correlate directly with the specification. It is suggested minimal (if any) revision to the specification occurs, in order to avoid clear and erroneous issues of the introduction of new matter. The specification appears to adequately enable the claimed invention, and so, any modification to the language of the specification would be improper. Rather, the modification of the submitted drawings, commensurate with the description(s) provided within the specification, is advised.

9. Additionally, see objection(s) to drawings, immediately following.

***Drawings***

10. All discussions concerning the drawings relate directly to the Figures submitted with the filed application on 3/31/2000.

11. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the user sets, functional modular components of the user set(s) including the database, controller, and swapping component(s), and network arrangement including primary and/or secondary servers, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

12. The drawings are further objected to under 37 CFR 1.83(a) because they fail to show, inter alia, various elements described in the specification. See, inter alia, Pages 7 and 8, and elements (10), (12), (14), (16), (18), (20), etc. The drawings and drawing elements simply do not correlate with the specification and claimed invention, as recited. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. See MPEP § 608.02(d).

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13. Lastly, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the various reference sign(s) mentioned in the description.

14. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

#### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

#### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the

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"Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

***Claim Objections***

15. Claim 10 recites five (5) functional steps which recite functional step labels "(a)" through "(f)". Step "(b)" has either been inadvertently omitted, or simply does not belong in the claimed invention. Since this improper "numbering" of the claimed inventive steps does not directly affect claim scope, it is suggested that step "(b)" be expressly provided within the claim, or this "numbering" of the logical designations for each step as recited in the claim be sequentially ordered.

***Allowable Subject Matter***

16. The provision for the modular document portioning and modification through the use of a plurality of client devices (user sets, as claimed), each of which comprising a list of undesired parameters dictating undesired document portion attributes, comparison functionality to determine the presence of undesired document portion(s), and functional element(s) executing "swap order(s)" acting to provide "null document portion(s)" in response to the determination of undesirable portions. Effecting the sending/transfer of a null document portion to a user set over a communications network in response to a "swap order" upon determination of undesirable document portions for modification of document(s) at the client computing terminal(s), as claimed, in the context of the present specification, was not expressly disclosed or suggested in the prior art of record. This functionality is provided and supported in the current specification, inter alia, at Page 16, Line 25 through Page 17, Line 24. Supporting Figure(s) are assumed to be forthcoming from Applicant.

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***Conclusion***

17. This application is in condition for allowance except for the formal matters detailed above. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc Thompson whose telephone number is (703) 308-6750. The Examiner can normally be reached on Monday-Friday from 9am to 4pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mark Powell, can be reached at (703) 305-9703.

The fax phone numbers for the organization where this application is assigned are as follows:

(703) 746-7238	(After Final Communications only)
(703) 746-7239	(Official Communications)
(703) 746-7240	(for Official Status Inquiries, Draft Communications only)

Inquiries of a general nature relating to the general status of this application or proceeding should be directed to the 2100 Group receptionist whose telephone number is (703) 305-3900, or Customer Service for Technology Center 2100 at (703) 306-5631.

MARC D. THOMPSON  
**MARC THOMPSON**  
PRIMARY EXAMINER  
Marc D. Thompson  
Primary Examiner  
Art Unit 2142